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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,215	12/16/2003	Thomas P. Pritchard	05-03-001	7683
45113	7590	09/08/2008		
Siemens Corporation Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830			EXAMINER STERRETT, JONATHAN G	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 09/08/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/737,215

Applicant(s)

PRITCHARD ET AL.

Examiner

JONATHAN G. STERRETT

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This **Non-Final Office Action** is responsive to 27 May 2008. Currently **Claims 1-4** are pending.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 is rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different

state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, **Claim 1** is non-statutory since it may be performed within the human mind. **Claims 2-4** depend on claim 1 and are thus rejected at least for the reason given above for **Claim 1**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kakita**, Howard; Yu, Edward; "Improving Process Maturity to Compete in the Desktop Printer Market", April 1998, PDMA Visions Magazine, pp.1-8, (hereinafter **Kakita**) in view of **Saiedian**, Hossein; Carr, Natsu,, "Characterizing a software process maturity model for small organizations" , ACM SIGICE Bulletin archive, Volume 23, Issue 1 (July 1997), Pages: 2 – 11, (hereinafter **Saiedian**).

Regarding **Claim 1**, Kakita teaches:

A method, comprising:

defining process stages of a business process;

Page 3 Figure 1, process stages of a development process (i.e. product development).

dividing the process stages into key process areas;

Page 3 Figure 2, key process stages are divided into key process areas (areas of competence from which maturity is determined).

rating the business process according to the key process areas to produce key process area ratings;

Page 3 Figure 2, for each area, a maturity rating is given (here it is rated before and after Xerox's TTM implementation).

compiling the key process area ratings;

Figure 2 is a compilation of these ratings

performing a business evaluation in accordance with the key process area ratings; and

Page 2 last paragraph, the business evaluation was performed in accordance with the key process areas (according to PRTM's maturity model).

creating a recommendation report corresponding to the business evaluation.

Figure 2 includes a plan with recommendations of where to improve process performance.

Kakita teaches rating according to process maturity but does not teach where the maturity ratings are levels of initial, repeatable, defined, managed and optimized.

Saiedian teaches the CMM level ratings of initial, repeatable, defined, managed and optimized. Saiedian teaches the application of this method into a product development process, so Saiedian and Kakita are analogous art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kakita regarding providing maturity level assessments to include the CMM maturity level assessments as taught by Saiedian, because it would have provided a predictable result by applying an industry standard approach to assessing maturity level into the process assessment taught by Kakita.

Regarding **Claim 2**, Kakita teaches:

The method of claim 1, wherein each process stage is associated with specific key process areas.

Figure 2 breaks down each process stage into specific key process areas (e.g. strategy and product planning, decision making, team organization & documentation and development processes & controls)

Regarding **Claim 3**, Kakita teaches a four point maturity scale as taught above. Kakita does not teach rating a business process on a 5-level scale. However Official Notice is taken that it is old and well known in the art to use a 5 level scale to assess maturity of a process. The steps known in the art of assessing maturity as taught by Kakita would provide a predictable result in determining 5 levels of maturity for a company to attain.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kakita to include assessing the organization on a five level scale, because it would have provided a predictable result in assessing where a company's level of maturity was.

Regarding **Claim 4**, Kakita teaches:

The method of claim 1, wherein the business process is rated according to a predefined digital maturity model.

Figure 1, the maturity model is predefined according to PRTM's process maturity model.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS 9-3-08

/Jonathan G. Sterrett/

Primary Examiner, Art Unit 3623

